

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/595,352	06/15/00	WHITESIDE	L WBC 7403US

001688 QM12/1106
POLSTER, LIEDER, WOODRUFF & LUCCHESI
763 SOUTH NEW BALLAS ROAD
ST. LOUIS MO 63141-8750

EXAMINER

SNOW, B

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

6
11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Ta

Office Action Summary

Application No.

09/595,352

Applicant(s)

Examiner

Bruce Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11, and 12 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 3738

Response to Amendment

1. The amendment filed on 6/18/01 utilizes a claim format which is not in accordance with 37 CFR 1.173(b)(2), however, the amendment was acted on in order to expedite the application. In response to this Office action, applicant must submit claims in accordance with 37 CFR 1.173(b).

Prior Art

Applicant's information disclosure statement, paper No. 2, fails to include the foreign patent documents and other publications cited on the patent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parchinski (4,650,491) in view of Mikhail (5,480,448).

Parchinski teaches a prosthesis comprising a shell 12 having a smooth inner sealing surface 22 (see figure 5); and a liner 14 including at least one circumferential peripheral annular seal 40, said seal engaging and said smooth sealing surface to restrict migration of debris between the interface of the shell and liner. However, Parchinski fails to utilize at least one screw hole. Mikhail teaches it is well know to utilize at least one screw hole 40 in a shell prosthesis. It would have

Art Unit: 3738

been obvious to one having ordinary in the art to have utilized at least one screw hole to more securely affix the prosthesis to an acetabulum.

Regarding the interlocking circumferential groove, see elements 28 and 38 of Parchinski.

Claim 9, see elements 30 of Parchinski and elements 257 of Mikhail.

Claim 11, Parchinski teaches rounded tab 48. It would be an obvious duplication of parts to have utilized more than one tab.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 12, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Allowable Subject Matter

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Applicant's Arguments

Applicant's arguments filed 6/18/01 have been fully considered.

Art Unit: 3738

Applicant's statement of inoperativeness or invalidity of the original patent stated, "*the reason of a defective specification in that I claimed less than I had a right to claim in the patent*" is accepted.

Applicant indicated that the patent was assigned to "Surgical Accessories, Inc" as recorded.

Regarding the I.D.S., applicant indicated that "*a supplemental information Disclosure Statement will be filed later to include those foreign patents and printed publication..*"

Regarding the recapture rejection under 35 U.S.C. 251, applicant argument's were persuasive.

Regarding the in rejection under 35 USC 102 as being anticipated by Schryver et al, applicant states that, "*the "liner" in FIG 9 of Schryver is in fact not a liner at all*" which is persuasive. Applicant specification describes a "liner" to be an acetabular shell liner as known in the art.

Applicant's argument with respect to the rejection under 35 U.S.C. 103(a) as being unpatentable over Parchinski (4,650,491) in view of Mikhail (5,480,448) is not deemed persuasive. Applicant states, *Parchinski clearly shows the shell 12 as being a ring having an opening 26 at the bottom of the shell which allows the liner to be completely exposed to the bone structure of the patient.*" Applicant continues, "*the polar region of shell 12 being removed to provide a large circular opening 26 for allowing visual assessment of bone apposition during insertion of shell 12 in the acetabulum.*" The Examiner fully agrees with these statements.

Art Unit: 3738

Applicant concludes, **“Therefore, Parchinski teaches away from using a shell which provides a sealing surface, because the shell 12 of Parchinski requires a large opening in the bottom of the shell thereby completely excluding the possibility that the shell can have a smooth inner sealing surface.”** This statement is not persuasive and applicant’s logic is greatly flawed. There is absolutely no connection being having a circular opening and a smooth inner sealing surface. In fact, applicant has provided no evidence that the shell does not have a smooth inner sealing surface. The Examiner strongly believes that the description in the specification describing element 22 as “cylindrical portion 22” and drawings thereof, teach a “smooth inner sealing surface.”

Parchinski teaches annular seal 40 is deformed or flexed in an interference fit against a smooth inner surface, given this configuration and the fact that these elements are made from the same material as taught by applicant, inherently, the annular seal 40 must restrict migration of debris between the interface of the shell and liner. Similar to a screw hole in the shell, circular opening 26 would allow an access for debris to the patient’s acetabulum. The fact that Parchinski does not functionally describe that the configuration restricts migration of debris between the interface of the shell and liner does not differentiate the claimed apparatus from the prior art apparatus satisfying the structural limitations of the that claimed.

Applicants argument regarding claim 9 is not persuasive. Parchinski clearly shows a plurality of peripheral notches 30 which are identified for use in orienting the insert 14. However, said notches will also provide securement against rotational movement of the shell relative to the

Art Unit: 3738

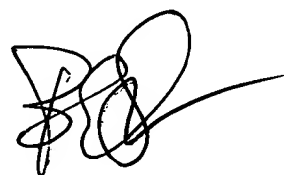
insert. It is also noted that Mikhail teaches many different securing means on the shell including "securing peripheral notches" 257 shown in figure 15. Regarding claim 11, it is the Examiner's position that duplication of rounded tab 48 in other positions, such as 180 degrees opposite, would help facilitate alignment during surgery if one tab was obstructed from the doctor's sight and would be an obvious to one having ordinary skill in the art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Bruce Snow at (703) 308-3255. Should the examiner not be present, Applicant may call the Examiner's Supervisor Corrine McDermott (703) 308-2111.

B. Snow
November 1, 2001



Bruce E. Snow
Primary Examiner
Group 3700

§ 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an

entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the approved changes must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on